

REMARKS

The amendments herein do not constitute an admission regarding the patentability of the amended subject matter and should not be so construed. Applicant reserves the right to pursue canceled subject matter in this or any other appropriate patent application.

The Examiner has required restriction of the application to one invention under 35 U.S.C. § 121. Specifically, the Examiner identifies the inventions as being:

Group I, consisting of claims 1-23, 38-42 and 44, drawn to an isolated human monoclonal antibody designated RM4, a composition, a pharmaceutical composition, and a kit thereof;

Group II, consisting of claims 24-32, 38-40, 43, drawn to an isolated human antibody designated RM2, a kit and a pharmaceutical composition thereof;

Group III, consisting of claims 33-37, drawn to a nucleic acid and a cell;

Group IV, consisting of claim 45, drawn to a method of producing an antibody;

Group V, consisting of claims 46-51, drawn to an *in-vitro* method of detecting the presence of AgRM4;

Group VI, consisting of claims 46-51, drawn to an *in vitro* method of detecting the presence of AgRM4;

Group VII, consisting of claim 52, drawn to a method of identifying an inhibitor of AgRM4 expression;

Group VIII, consisting of claims 53-83, drawn to a method of inhibiting the proliferation of a cell that expresses AgRM4;

Group IX, consisting of claim 84, drawn to a method of screening for the presence of a hyperproliferative disorder in a subject comprising contacting the tissue *in vitro* with a RM4 antibody and assaying for the presence of AgRM4; and

Group X, consisting of claim 84, drawn to a method of screening for the presence of a hyperproliferative disorder in a subject comprising contacting the tissue *in vivo* with a RM 4 antibody and assaying for the presence of AgRM4.

Pursuant to 37 C.F.R. § 1.142, Applicants hereby elect to prosecute the invention encompassed by Group VIII, claims 53-83, drawn to a method of inhibiting the proliferation of a cell that expresses AgRM4, classified in class 424, subclass 130.1, without traverse. The Applicants have amended the pending claims of Group VIII so that they no longer depend on withdrawn claims.

The Examiner has further stated that the selected invention, Group VIII, contains claims directed to patentably distinct species in several categories.

Regarding claims 54-55, the Examiner has identified the following species of proliferating cells: brain, lung, skin, and pancreatic. To facilitate the prosecution of claims of Group VIII of the instant application, the Applicants elect proliferating lung cells for examination on the merits. Following this election, claims 54-55 read on the elected species. Additionally, following this election, claims 53, 54, 59-71 and 73-83 read on the elected species; however, note that the elected species here, "lung," does not read on the elected species in claims 58 and 63.

Regarding claims 56-58, the Examiner has identified the following species of hyperproliferating cells: metastatic breast, metastatic colon, metastatic gut, metastatic lung, non-metastatic breast, non-metastatic colon, non-metastatic gut, and non-metastatic lung. To facilitate the prosecution of claims of Group VIII of the instant application, the Applicants elect metastatic colon hyperproliferating cells for examination on the merits. Following this election, claims 56-58 read on the elected species. Additionally, following this election, claims 53, 54, 59-71 and 73-83 read on the elected species; however, note that the elected species here, "metastatic colon," does not read on the elected species in claim 55.

Regarding claim 71, the Examiner has identified the following species of tumor stages: I, II, III, IV, and V. To facilitate the prosecution of claims of Group VIII of the instant application, the Applicants elect stage IV tumors for examination on the merits. Following this election, claim 71 reads on the elected species. Additionally, following this election, claims 53-71 and 73-83 read on the elected species.

Regarding claims 72-76, the Examiner has identified the following species of tumors: solid, liquid, breast, colon, gut, lung, hematopoietic, metastatic, non- metastatic, sarcoma, carcinoma, melanoma, myeloma, blastoma, lymphoma, and leukemia. To facilitate the prosecution of claims of Group VIII of the instant application, the Applicants elect metastatic tumors for examination on the merits. Following this election, the elected species reads on claims 73, 75, and 76; also one of skill in the art would understand that metastatic tumors arise from and comprise solid tumors, and thus the elected species also reads on claim 72. The relation between solid tumors and metastatic tumors is confirmed by the definition provided by the specification at paragraph 126 as provided by the U.S. P.T.O. on their website (U.S. Patent Application No. 20050031621) and beginning at line 28, page 34 of the application as filed. Additionally, following this election, claims 53-71 and 73-83 read on the elected species.

Claims 1 – 52 and 84 are withdrawn from consideration as being drawn to non-elected subject matter.

Applicants also reserve the right pursuant to 35 U.S.C. § 121 to file one or more divisional applications directed to the non-elected invention during the pendency of the present application. In the event of allowable product claims, Applicants reserve the right to request rejoinder of process claims that depend from or otherwise include all the limitations of allowable product claims.

CONCLUSION

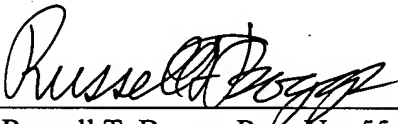
Applicants respectfully request prompt and favorable action on claims 53 through 83. No fees are believed to be due in connection with this submission. However, if Applicants are incorrect in this assumption, please charge any fee due to Deposit Account No. 23-2415 (referencing attorney docket 31302-702).

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (858) 350-2309.

Respectfully submitted,

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Date: November 7, 2005



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